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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,925	12/09/2003	Karim M. Gabriel	GAP02U	6666

32047 7590 11/15/2005

GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC  
55 SOUTH COMMERICAL STREET  
MANCHESTER, NH 03101

EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/731,925

Applicant(s)

GABRIEL, KARIM M.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/31/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' amendment filed on August 31, 2005 was received. Claims 1 and 5 are amended. Now, Claims 1-5 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 0205) is/are removed.
3. Claim rejection(s) (except Claim 5) under 35 USC 102 in paragraph 5 of the previous Office Action (Paper No. 0205) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0205).

#### ***Claim Rejections - 35 USC § 112***

5. Claim 1-4 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of a polyester polyol or polyether polyol (page 4, line 21 to page 5, line 3), does not reasonably provide enablement

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for the use of any polyester or any polyether. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

6. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Claim 1 (lines 5-6) and Claim 5 (lines 9-11), Examiner is not able to find the basis for an organofunctional silane consisting essentially of one or more silicon-bonded hydrolysable groups. (Emphasis added) Especially, Applicants state in Remarks, page 9, 3<sup>rd</sup> paragraph that this “consisting essentially of” is intended to exclude functionality, such as aspartic acid diester functionality”. Note that in Applicants’ specification, all organofunctional silanes contains functional groups in addition to the hydrolyzable silyl groups (page 7, line 2 to page 9, line 6)

7. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Claim 5 (line 6), Examiner is unable to find the basis for “consisting essentially of”.

***Claim Rejections - 35 USC § 102 and 103***

8. Rejection of Claim 5 under 35 USC 102(b) as being anticipated by Bahadur (US 6 258 878) is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 0205. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants primarily argue that Bahadur does not teach a composition consisting essentially of an organometallic catalyst and an oligomeric or polymeric resin having specific number of silyl functionality. However, in view of the rejection set forth in paragraph 7 above, Bahadur still anticipates the instant claim before this particular rejection set forth in paragraph 7 being overcome.

9. Rejection of Claims 1-4 under 35 USC 102(b) as being anticipated by Waldman (US 6 001 946) and rejection of Claim 5 under 35 USC 103(a) as being

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unpatentable over Waldman are maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 0205. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 8, 3<sup>rd</sup> and 4<sup>th</sup> paragraphs and page 10, 3<sup>rd</sup> paragraph), in view of the rejection set forth in paragraph 6 above, Waldman's N-silylalkyl aspartic acid ester as a whole reads on Applicants' organofunctional silane (Emphasis added) before this particular rejection set forth in paragraph 6 being overcome. Applicants appear to relate Waldman's  $H_2N-T_1-X_b-Q_q-Si(R^3)_a(R^4)_{3-a}$  to the organofunctional silane in the present invention. However, as mentioned above, it is Waldman's N-silylalkyl aspartic acid ester that corresponds to organofunctional silane in the present invention. Arguing how N-silylalkyl aspartic acid ester is prepared and the disadvantage of using it is irreverent.

For Applicants' argument (Remarks, page 9, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs), note that the statement "The present invention does not require the organofunctional silane to be reacted with an unsaturated maleate diester prior to silation of the polymer" is not supported by the claims in the present invention.

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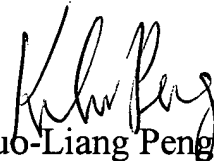
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application

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or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
November 10, 2005

  
Kuo-Liang Peng  
Primary Examiner  
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